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**MYRON AMER, P.C.**  
Patents, Trademarks & Copyrights

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# Fax

To: Caroline Brown	From: Myron Amer
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Re: Our File No. P-3925-1	Date: May 25, 2005

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## MESSAGE:

RE: Serial No. 09/864,350  
for TILE WET SAW WITH OUTWARDLY  
DIVERGING CUTTING MODE

As requested, attached is a copy of the BRIEF OF APPLICANT filed in the U.S. Patent and Trademark Office on February 10, 2003.

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Ser. No.: 09/864,350

File No.: P-3925-1

Date: January 29, 2003

Applicant: Martin Cullen

For: TILE WET SAW WITH OUTWARDLY  
DIVERGING CUTTING MODE

The Patent Office date stamped hereon will acknowledge receipt of BRIEF OF APPLICANT, filed in triplicate, and check in the amount of \$160; and self-addressed return envelope.

#26/Appeal  
Brief

P-3925-1

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

M. WAITS  
6/14/05

APPLICANT: MARTIN CULLEN  
FOR: TILE WET SAW WITH OUTWARDLY DIVERGING CUTTING MODE  
SERIAL NO.: 09/864,350  
FILED: May 25, 2001  
EXAMINER: Maurina T. Rachuba, Primary Examiner, Art Unit 3723

BRIEF OF APPLICANT

Hon. Commissioner of Patents  
and Trademarks  
Washington, DC 20231

Sir:

Applicant appeals the Final Rejection of 09/24/02 and herewith submits BRIEF OF APPLICANT.

**1. Real Party in Interest**

The applicant above named.

**2. Related Appeals or Interferences**

None.

**3. Status of Claims**

There are two claims on appeal as respectively set forth in Appendix A and Appendix B.

**4. Status of Amendments after Final Rejection**

A PETITION PURSUANT TO 37 CFR 1.181(a)(3) was filed to have claim 2 of Appendix B considered on the merits. This Petition was denied but with a holding that applicant may request the within reconsideration of the denial now being timely made.

#### 5. Summary of Invention

Underlying the present invention is the recognition that a popular standard size ceramic tile (6 inch square and smaller) and a popular standard size cutting tile wet saw blade (diameter greater than 6 inches) can be correlated to provide noteworthy results in the preparation of the tile for end uses, such as cutting the tile in two along a line parallel to a side or on a diagonal from corner to corner as needed in a miter joint

The referred to "popular standard size cutting tile wet saw blade" is the blade of the cited prior patent to Sigetich et al. ("Sigetich" title saw) illustrated and designated PRIOR ART in Fig. 2 and having an operating mode in cutting the referred to "popular standard size ceramic tile" illustrated and designated PRIOR ART in Fig. 1.

#### Sigetich Tile Saw and Operating Mode

The typical six inch square tile T, depicted in Fig. 1, is cut along the cutting path T1, starting at the starting point T2 to the end of the path T3, resulting in the separated two parts T4 and T5, wherein the cutting in two is in accordance with the operating mode of the Fig. 2 Sigetich tile wet saw, generally designated 1.

#### Applicant's Use of a Sigetich-type Title Saw and Modified Operating Mode thereof

A typical six-inch square tile T', depicted in Fig. 3, is also cut in two parts T4' and T5', but along a cutting path T1', wherein the cutting path starts at a medial location, as at T2',

and progresses outwardly in the opposite directions TL3' and TR3', and is in accordance with the operating mode of the tile wet saw, generally designated 70, of the present invention. The cutting paths T3 and TL3', TR3', although both effective in producing the separation in two of a typical standard sized tile T, T', are otherwise substantially distinguishable, the latter or that of applicant taking considerably less time and effort. (Application page 3, line 12 to page 4, line 2)

To provide cutting service to the saw 70, use is made of a circular blade 72 having a peripheral cutting edge 74 and of a selected diameter 76 of at least approximately six inches, wherein the blade 72 is powered in rotation by an electric motor 78 within a housing 80 having opposite ends 82 and 84. At one end 82 are pivot means 86 for mounting the housing 80 to partake of pivotally traversing movement 88 and at the opposite end 84 are means, as at 90, for journalling the blade 72 for rotation and in extending relation, as depicted at 92, depending from the housing 80.

A ceramic tile T', of the selected six inch square configuration, is supported on a tile support 94 which provides a positioning location at an end of and in aligned relation to the path of the pivotal traversing movement 88 of the housing.

As a consequence, the thusly positioned tile T' is adapted to be contacted by the cutting blade cutting edge 74 initially centrally, as at T2', of the proposed tile-separating cut T1' during the initial pivotal traversing descent 96, and during continued pivotal traversing descent 98, as best understood from Fig. 4, so that the tile-separating cut T1' progressively enlarges in opposite outward directions TL3' and TR3', until the tile T' is shaped into two parts T4' and T5', which in practice has been noted to occur in an optimum nominal time.

Stated somewhat differently, the simultaneous opposite direction outward progression of the tile severing cut T1' of a pivotal traverse 88 is achieved in significantly less time than the prior art tile severing cut T1 which starts at a site T2 at one end and progresses only in one direction therefrom until the end T3 of the cut is reached, this prior art shortcoming resulting from urging the tile in longitudinal movement T1 in relation to the rotating cutting blade 33 having no pivotal traversing degree of movement, whereas in contrast, the cutting of the tile with a pivotal traverse is effective to produce cutting of the tile simultaneously in outward opposite directions from the site T2' and completes a total 6 inch cut when a chord 100 of the blade of a 6 inch dimension, which is the size of the tile cut needed to separate the tile in two, descends through the plane 104 of the tile into the notch 102. (Application page 9, lines 11-21)

It is preferred that by appropriate diameter size 76 selection for the blade 72 that the tile T' be severed in two T4', T5' by descent of the blade 72 through the plane 104 of the tile T' to the extent necessary, but as an alternative, and not shown since the instructions which follow suffice for one well versed in the art, the stationary tile support 94 can be converted to a carriage by being embodied with wheels tracking in transverse tracks so that the tile support 94 can be urged in nominal opposite linear movements to complete the cut through the tile end length portions not cut in the blade descent. (Application page 9, line 22 to page 10, line 5)

6. **Issues pursuant to 37 CFR 1.192(e)(6).**

Issue A

Whether claim 2 of Appendix B is properly withdrawn from consideration as being directed to a non-elected invention.

Issue B

Whether claim 1 of Appendix A is properly rejected under 35 U.S.C. 102(b) as being anticipated by Sigetich et al.

**7. Grouping of Claims**

Grouping does not apply.

**8. Argument pursuant to 37 CFR 1.192(c)(8).**Issue A

If claim 2 of Appendix B is deemed to have been improperly withdrawn by the examiner, it has been conceded by the examiner that it is not anticipated by cited Sigetich et al. In the Office Action of 07/11/2002, the examiner states that she "agrees that the method of operation of Sigetich et al. may differ from applicant's method operation . . ." and goes on to say, citing MPEP § 806.05(e) as the basis for the withdrawal, that "the apparatus can be used for another materially different process, such as wood cutting."

Applicant disputes the applicability of MPEP 806.05(E). More particularly, it has not been shown that the process *as claimed* can be practiced by another materially different apparatus or by hand. Rather, to the contrary, the examiner contends that the Sigetich et al. and applicant's apparatuses are not materially different, but are substantially the same. Applicant's claim of a patentable advance is that the substantially similar apparatuses--constructionwise--are used differently by applicant to achieve a utility that has eluded Sigetich et al.

The suggestion of the use of a method practiced "by hand" also made by the examiner to support her refusal to examine claim 2 is disingenuous since the object is to reduce tedium in shaping tiles, and to go to a hand method is totally out of the question.

Nor has the alternative been shown "that the apparatus *as claimed* can be used to practice another and materially different process."

As claimed, claim 1 is to "a ceramic tile shaping saw," and there is nothing of record to support the contention that it can be used for "cutting wood molding." In WEBSTER'S COLLEGE DICTIONARY, a "wood molding" is defined as "a strip of contoured wood . . . placed on a wall, just below the juncture with the ceiling."

Thus, as claimed, in cutting wood molding what would be the purpose of:

" . . . a descending movement of said housing along said path of said pivotal traversing movement effective to establish the contacting by said cutting blade centrally of a start of a first proposed cut therein during an initial pivotal traversing descent and during continued pivotal traversing descent a progressively enlargement thereof in one direction incident to contact with a length portion of said cutting blade in leading relation to said first cut and incident to contact with a length portion of said cutting blade in trailing relation to said first cut in an opposite direction until said [wood molding] is shaped into two parts, whereby said shaping is achieved in an optimum nominal time than would have entailed making said cut from one end thereof to the opposite end thereof." (Underlined reference added).

Claim 2 should be entered of record and deemed allowable as not anticipated by Sigelich et al.

#### Issue B

It has been the examiner's position throughout that although applicant has argued that the title saw disclosed by Sigelich et al. does not function as applicant's saw, that:

"The recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a

manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). (emphasis added)."

Applicant's response to the above is twofold.

First

The cited 1967 and 1963 cases have been reversed by the more recent 1998 decision by the Board of Patent Appeals and Interferences in Ex parte Hervy A. Morris, 1998 Vol. 1736155 (Bd. Pat. App. & Interf.).

More particularly, in the enclosed "Decision On Appeal" of Ex parte Hervy A. Morris, annexed hereto for convenient reference, the Board expresses the better view that "[t]here is nothing intrinsically wrong in defining something by what is (sic) does rather than by what it is", citing In re Echard, 471 F.2d 632, 635, 176 USPQ 231, 322 (CCPA 1973).

Second

The structural claim of Appendix A does in fact structurally distinguish over Sigitich et al. in the below recitations:

"... a descending movement of said housing along said path of said pivotal traversing movement effective to establish the contacting by said cutting blade centrally of a start of a proposed cut therein during an initial pivotal traversing descent and during continued pivotal traversing descent a progressively enlargement thereof in opposite outward directions until said tile is shaped into two parts."

The fact that the prior art structure could be modified does not make such a modification obvious in the absence of the prior art suggesting the desirability of doing so (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 984)).

The refusal of the examiner to acknowledge the differences in the methods disclosed by Sigetich et al. and claimed by applicant without a "structural" difference, does not follow the precedent of In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) and, more particularly, the holding therein that on the issue of anticipation all limitations of a claim must be considered, i.e., the reference to the proposition "the name of the game is the claim," which appears on the cited page of Hiniker.

What was stated in principal by the Board in Ex parte Hervy A. Morris with respect to the Driver patent involved in that case is also applicable to the Sigetich et al. patent involved in this case, namely that there is an absence of operating mode disclosure and by virtue of this absence, there is no claim anticipation.

Respectfully,

MYRON AMER, P.C.  
Attorney for Applicant

By:

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Dated: January 28, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on January 29, 2003.

Dated: January 29, 2003

Appendix A

1. A ceramic tile shaping saw comprising a circular blade having a peripheral cutting edge and of a diameter of at least 6 inches, motor means connected to power said circular blade in rotation, a saw housing having opposite ends, means at one end for mounting said housing for pivotally traversing movement, means at said opposite end for journalling said circular blade for rotation in extending depending relation therefrom, a ceramic tile at least of a 6 inch square configuration, a tile support in positioning relation beneath said tile and having an operative position located at an end of and in aligned relation to said path of said pivotal traversing movement of said housing, a descending movement of said housing along said path of said pivotal traversing movement effective to establish the contacting by said cutting blade centrally of a start of a first proposed cut therein during an initial pivotal traversing descent and during continued pivotal traversing descent a progressively enlargement thereof in one direction incident to contact with a length portion of said cutting blade in leading relation to said first cut and incident to contact with a length portion of said cutting blade in trailing relation to said first cut in an opposite direction until said tile is shaped into two parts, whereby said shaping is achieved in an optimum nominal time than would have entailed making said cut from one end thereof to the opposite end thereof.

Appendix B

2. A method of cutting in half in an optimum time a four-sided tile of ceramic construction material delimited by a front side, a rear side, a left side and a right side comprising the steps of:
  - A. supporting from beneath said front and rear sides said tile in a horizontal orientation with a central clearance therebeneath at a tile-cutting work station;
  - B. using a motor-operated circular cutting blade with a peripheral cutting edge at said tile-cutting work station mounted to partake from a starting clearance position a pivotal traverse to an operative position of movement into said central clearance beneath said tile with said cutting blade oriented perpendicularly of said left and right sides of said tile;
  - C. positioning said tile with a center line and a central point therealong in the path of said pivotal traverse of said cutting blade;
  - D. urging initially said cutting blade in said pivotal traverse into cutting contact at said central point of said tile to establish a start of a tile-severing cut along said center line;
  - E. continuing said pivotal traverse so as to cause said tile-severing cut starting in said tile simultaneously to enlarge in opposite directions along said center line until said left and right edges;

whereby said tile is cut in half in significantly less time than if said cut started in an edge thereof.

KeyCite Citing

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(Cite as: 1998 WL 1736155 (Bd.Pat.App &amp; Interf.))

\*1

## Board of Patent Appeals and Interferences

Patent and Trademark Office (P.T.O.)  
EX PARTE HERVY A. MORRIS  
Appeal No. 98-2109  
Application No. 08/500,315 [FN1]

NO DATE REFERENCE AVAILABLE FOR THIS DOCUMENT

Kokjer, Kircher, Bowman and Johnson  
2414 Commerce Tower  
911 Main Street  
Kansas City, MO 64105-2088

Before CALVERT, NASE, and CRAWFORD  
Administrative Patent Judges

CALVERT  
Administrative Patent Judge

## ON BRIEF

## DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 3, 5 and 9 to 11, the examiner having indicated in the answer that, as to the other claims remaining the application, claims 21 to 24 are allowed, and claims 4, 20 and 25 would be allowable if rewritten in independent form.

The subject matter in issue is exemplified by claim 1, the only independent claim on appeal, which reads (emphasis added):

A liquid-jet cutting device comprising:

a cutting element for emitting a liquid-jet stream to cut a product located upon a product support surface;

an assembly for moving the cutting element between a cutting position located a cutting distance, within a cutting range, from the product and an idle position located an idle distance from the product support surface; and

a deflector disk, located proximate the idle position of the cutting element to deflect the liquid-jet stream when the cutting element is moved to the idle position.

The reference applied in the final rejection is:

Driver 5,318,395 Jun. 7, 1994

Claims 1 to 3, 5 and 9 to 11 stand finally rejected as being anticipated by

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(Cite as: 1998 WL 1736155, \*1 (Bd.Pat.App & Interf.))

Driver, under 35 U.S.C. § 102(b).

We note initially that on page 11 of the brief, appellant argues that Driver: nonanalogous art. This argument will be given no consideration, because it is well settled that "the question whether a reference is analogous art is irrelevant to whether that reference anticipates." *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

The basis of the rejection is set forth on pages 3 and 4 of the final rejection (Paper No. 11).

Appellant argues that Driver does not anticipate claim 1 because there is no disclosure of the two limitations underlined in the copy of the claim, supra. With regard to the first of these limitations, i.e., the recitation "to cut a product located upon a product support surface," the examiner argued in the final rejection (page 7) that Driver meets this limitation because the pipeline 30 supports the product (liner) 35 to be cut. Appellant, on the other hand, asserts that this limitation must be interpreted "to be a surface which supports the product around where it is being cut," otherwise the limitation is superfluous (brief, page 7).

It is fundamental that during the examination of an application, the pending claims must be interpreted as broadly as their terms reasonably allow, and that limitations appearing in the specification may not be read into the claims. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). Here, all that claim 1 specifies is that the product is "located upon a product support surface," and does not require that the product be supported at the point where it is being cut. Driver's liner 35, the product being cut, is located upon the surface of pipe 30 which supports it; therefore, interpreting the limitation in question as broadly as reasonable, it is met by Driver, even though Driver's liner 35 is not supported (i.e., backed up) by pipe 30 at the point where it is being cut by the liquid from nozzle 604. If this limitation is superfluous, as argued by appellant, that is simply an indication of its breadth.

\*2 Turning to the second limitation in dispute, the examiner argues (answer, pages 5 and 6):

[t]he phrase "to deflect the liquid-jet stream ...." should not be construed as defining structure. It does not describe any structure; it merely expresses what the disk is desired to do. However, it has well been established that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, [370 F.2d 576, 580,] 152 USPQ 235[ , 238] (CCPA 1967); *In re Otto*, [312 F.2d 937, 940,] 136 USPQ 458, 459 (CCPA 1963). Therefore, it is irrelevant whether Driver's disk deflects fluid when the cutting element is moved to the idle position. However under certain conditions such as when Driver's device is inserted in a pipe section that already has been ported, Driver's disk will certainly deflect fluid when the cutter is moved to the idle position as there is no liner material between the cutting element and the disk to hinder the stream of fluid from hitting the disk.

Although we appreciate the examiner's position, we do not agree with his argument, because in our view the disk 620 of Driver is not capable of performing

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(Cite as: 1998 WL 1736155, \*2 (Bd.Pat.App & Interf.))

the intended use recited, i.e., of "deflect[ing] the liquid-jet stream when the cutting element is moved to the idle position." While the disk 620 is located "proximate the idle position" of cutting element (nozzle) 604, as claimed, it cannot perform the function of deflecting the jet from the nozzle 604 when the nozzle is in the idle position (Fig. 7), because, since nozzle 604 does not emit a jet when it is in that position there is no jet to be deflected; as disclosed by Driver at col. 5, lines 27 to 36 (see also claim 5), supplying fluid to cutter 600 will cause the nozzle 604 to move outward (from the Fig. 7 idle position) and contact the inside wall of the liner (Fig. 8). The examiner's statement in the last sentence of the above-quoted argument is not understood, since a stream of fluid is not emitted from Driver's nozzle 604 when it is in the idle position.

Our conclusion that claim 1 is not readable on the Driver apparatus is not contrary to the Otto or Casey decisions cited by the examiner. [FN2] Unlike those cases, the present limitation does not constitute "a method concept" which may not be relied on to distinguish a structural claim over the prior art (Otto, *id.*), or a manner or method of using the claimed machine "which is not germane to the issue of patentability of the machine itself" (Casey, *id.*). Rather, the limitation is in the nature of a structural limitation, in that it effectively requires a cutting element which is capable of emitting a liquid-jet stream when in the idle position; otherwise, there would be no stream for the disk to deflect. Driver does not disclose a cutting element which can operate in such a manner, and therefore does not anticipate claim 1. We note in this regard that "[t]here is nothing intrinsically wrong in defining something by what it does rather than by what it is." *In re Echard*, 471, F.2d 632, 635, 176 USPQ 321, 322 (CCPA 1973).

\*3 Accordingly, the rejection of claim 1, and therefore of claims 2, 3, 5 and 11 dependent thereon, will not be sustained.

#### Conclusion

The examiner's decision to reject claims 1 to 3, 5 and 9 to 11 is reversed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

#### BOARD OF PATENT APPEALS AND INTERFERENCES

IAN A. CALVERT  
Administrative Patent Judge  
JEFFREY V. NASE  
Administrative Patent Judge  
MURRIEL E. CRAWFORD  
Administrative Patent Judge

FN1. Application for patent filed July 10, 1995.

FN2. See also *In re Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1431 ("the recitation of a new intended use for an old product does not make a claim to the

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